

Attorney Docket No.: UT-0033
Inventors: Mujtaba et al.
Serial No.: 10/009,455
Filing Date: April 19, 2002
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REMARKS

Claims 1-8 are pending in the instant application. Claims 1-3, 7 and 8 have been withdrawn from consideration by the Examiner and subsequently canceled without prejudice by Applicants in this amendment. Claims 4-6 have been rejected. Claims 4 and 6 have been canceled. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement

The Examiner has made final the Restriction Requirement mailed December 15, 2004. Thus, in an earnest effort to advance the prosecution of this case, Applicants have canceled without prejudice claims 1-3, 7 and 8 drawn to non-elected subject matter. In light of the finality of this Restriction Requirement, Applicants reserve the right to file a divisional application to the canceled subject matter.

II. Amendment to Specification

In accordance with the Examiner's suggestion, Applicants have amended the specification to include reference to the PCT application and the provisional application from which the instant application claims priority.

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III. Rejection of Claims 4-5 under 35 U.S.C. 103(a)

Claims 4 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (March 1998, Reference BF). The Examiner suggests that it would have been obvious to one of ordinary skill in the art to isolate the cells from a mouse because Rao et al. disclose the use of rats for isolating the cells. The Examiner suggests that to obtain them in an amount of greater purity of 95% while using the methods of obtaining these cells as disclosed by Rao et al. would have been expected to provide successful results.

Applicants respectfully traverse this rejection.

At the outset, it is respectfully pointed out that claim 4 has been canceled.

Further, with respect to claim 5, it is respectfully pointed out that the starting material of the claimed method from which the mouse GRP cells are isolated, namely mouse embryonic stem cells, is different from the starting material taught by Rao et al., namely spinal cords of E13.5 rats. Further, there is no teaching or suggestion in Rao et al. to use any other cell type.

MPEP 2116.01 is clear; All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. Proper claim

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construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. MPEP 2116.01.

Since Rao et al. is silent with respect to use of any other starting material than those of the rat 13.5E spinal cord, this reference clearly provides no motivation to use of embryonic stem cells as claimed. Accordingly, this rejection under 35 U.S.C. 103 should not be sustained.

Withdrawal of this rejection under 35 U.S.C. 103(a) is therefore respectfully requested.

IV. Rejection of Claims 4-6 under 35 U.S.C. 103(a)

Claims 4-6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (U.S. Patent 6,361,996). The Examiner suggests that the claims differ from Rao et al. in that greater than 95% purity is not claimed. However, the Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to increase the number of glial restricted cells obtained by the methods of Rao et al. in order to enhance the purity of the population because these cells are present in the central nervous system at a level of 90%.

Applicants respectfully traverse this rejection.

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At the outset, it is respectfully pointed out that claims 4 and 6 have been canceled.

Further, with respect to claim 5, as discussed in Section III in detail, the starting material of the claimed method from which the mouse GRP cells are isolated, namely mouse embryonic stem cells, is different from the starting material taught by Rao et al., namely cells derived from a neural tube.

MPEP 2116.01 is clear; All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. Proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. MPEP 2116.01.

Rao et al. provides no motivation to use embryonic stem cells as claimed. Accordingly, this rejection under 35 U.S.C. 103 should not be sustained.

Withdrawal of this rejection is therefore respectfully requested.

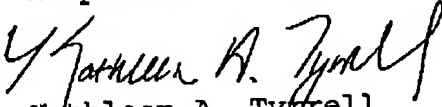
V. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

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Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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Date: August 3, 2005

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